

**REMARKS/ARGUMENTS**

This Application has been carefully reviewed in light of the Office Action mailed September 6, 2006. Claims 1-31 were filed in this Application of which claims 25-31 are cancelled, claims 1, 9, 14, 17, and 22 are currently amended, and no claims are currently added. Thus, Claims 1-24 are currently pending in this Application.

Claims 1, 9, and 17 have been amended to correct typographical errors. Claims 14 and 22 have been amended to correct issues related to antecedent basis as identified by the Examiner. No new matter is intended or believed to be added by these amendments.

In view of the following remarks and amendments to the claims, Applicants respectfully submit that all of the claims of the above-identified application are in condition for allowance. Reconsideration of the claims is respectfully requested.

**I. 35 U.S.C. § 101 (Claim 9)**

The Examiner has rejected claim 9 under 35 U.S.C. § 101 because it is alleged that claim 9 is directed to non-statutory subject matter. The Examiner states that "claim 9 recites a computer program product in a computer readable medium; however, the applicant's specification defines a computer readable medium as including transmission-type media such as digital and analog communications links." The Examiner further states that "[d]ata, which is on a transmission link, is deemed a signal and is not tangible." Without acquiescing in the Examiner's interpretation of 35 U.S.C. § 101 and in the interest of furthering prosecution, the Applicant amends the

specification to remove the phrase "and transmission-type media such as digital and analog communications links." Therefore, the computer readable media of claim 9 does not include transmission-type media and, thus, claim 9 is directed toward statutory subject matter. Therefore, the rejection of claim 9 as drawn to non-statutory subject matter has been overcome.

**II. 35 U.S.C. § 112, (Claims 14 and 22)**

The Examiner has rejected claims 14 and 22 under 35 U.S.C. §112 because claims 14 and 22 recite the limitation "the step" in the claim language. The Examiner states that "[t]here is insufficient antecedent basis for this limitation in the claim[s]" because "[p]aren't claims 9 and 17 do not recite the "step" as claimed in the respective dependent claims since they are not written as method claims." Claims 14 and 22 have been amended accordingly. Therefore, the rejection of claims 14 and 22 under 35 U.S.C. §112 has been overcome.

**III. 35 U.S.C. § 102, Anticipation (Claim 25)**

The examiner has rejected claim 25 under 35 U.S.C. §102(b) as being anticipated by Cassidy et al. (U.S. patent No. 6,249,883). This rejection is rendered moot in light of the cancellation of claim 25.

**IV. 35 U.S.C. § 103, Obviousness (Claims 1-6, 9-14, and 17-22)**

The examiner has rejected claims 1-6, 9-14, and 17-22 under 35 U.S.C. §103(a) as being unpatentable over Cassidy et al. (U.S. Patent No. 6,249,883) in view of Ghaffar et al. (U.S. Patent application Publication US2004/01764A1). This rejection is respectfully traversed.

In rejecting claim 1, the Examiner states that "Cassidy does not explicitly teach correcting the error if an error exists. Ghaffar does teach correcting the error if an error exists (paragraph 0010, lines 1-5)." (Office Action, page 4, line 7-8). The Examiner further states that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use the failure correction process of Ghaffar in the failure detection process of Cassidy." (Office Action, page 4, lines 8-11).

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. at 687. Thus, when Ghaffar is examined as a whole, Ghaffar teaches one of ordinary skill in the art a system which requires a user to invoke a self-support application to diagnose an error identified by the user and produce an error code to be used by a service center to attempt to resolve the user's problem which teaches away from determining whether an error exists based upon replication information received from the directory service as recited in claim 1, as amended, of the present application. (See, for example, Ghaffar, paragraphs 19, 20, 23, and 24). This user intensive feature of error determination for individual user applications and computers is quite different from the automated error determination and correction system for networks provided by claim 1. The only mention or need of a network provided for by Ghaffar is a means for a user and the user's computer of communicating with a service support center

that a user may telephone in order to aid the service support center in diagnosing and providing solutions to the consumer user. Therefore, one of ordinary skill in the art would not be motivated to make the examiner's proposed changes.

Furthermore, even if Cassidy and Ghaffar could be properly combined, a combination of Cassidy and Ghaffar would not form the presently claimed invention in claim claim 1. Instead, a combination of Cassidy and Ghaffar would result in system in which a user or network administrator would have to notice a problem and then invoke a self-support application in which the user is prompted to answer a series of questions in order to determine where the error occurred and what it was. However, claim 1 as amended does not require user intervention in order to determine whether an error occurred.

In order to rely on a reference as a basis for rejection, the reference must be either in the applicant's field of endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986). It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). However, the claims of the present application are directed towards monitoring replication of domain controllers and correcting problems with replication within a directory service environment. In contrast, the

teachings of Ghaffar are directed toward improving efficiencies for customer support centers in resolving issues with computer hardware and software encountered by a user, such as a person operating a personal computer from their home. Although both of these areas related to computer software, they are completely non-analogous because of the disparities in problems addressed and solved. Computer software is an enormous industry that includes numerous sub-specialties each with its own conventions, techniques, and idiosyncrasies. Therefore, the mere fact that the present invention and Ghaffar both relate to computer software is insufficient to demonstrate that the art of Ghaffar is analogous to that of the present application.

A fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Therefore, a rule that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention." Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention. The inquiry is not whether each element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 100, 2 U.S.P.Q.2d 1826 (Fed. Cir. 1987). The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re*

*Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The examiner may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification. In the instant case, the Examiner has made general statements of desirability of the modifications using motivation provided by the present application and the Examiner's opinions read into the prior art. However, nothing in Ghaffar or Cassidy states a desire to include a "failure correction process". Thus, even if the combination of Cassidy and Ghaffar resulted in a combination as recited in claim 1, the motivation to combine the two references is lacking.

Therefore, claim 1 is not rendered obvious by Cassidy in view of Ghaffar. Claims 9 and 17 recite similar limitations to that of claim 1, therefore, the same arguments in support of patentability as provided for claim 1 above apply equally to claims 9 and 17. Therefore, claims 9 and 17 are not rendered obvious by Cassidy in view of Ghaffar. Furthermore, 2-6, 10-14, and 18-22 depend from respective ones of claims 1, 7, and 17 and include all of the limitations of these parent claims as well as additional limitations. Therefore, for the reasons provided above, claims 2-6, 10-14, and 18-22 are not rendered obvious by Cassidy in view of Ghaffar.

Thus, the rejection of claims 1-6, 9-15, and 18-22 under 35 U.S.C. § 103(a) has been overcome.

**V. 35 U.S.C. § 103, Obviousness (Claims 7-8, 15-16, and 23-24)**

The examiner has rejected claims 7-8, 15-16, and 23-24 under 35 U.S.C. §103(a) as being unpatentable over Cassidy in view of Ghaffar and further in view of Bazerman et al. (U.S. Patent No. 6,850,253). This rejection is respectfully traversed.

Claims 7-8, 15-16, and 23-24 depend from respective ones of claims 1, 9, and 17. Therefore, these claims include all of the limitations of their respective parent claims as well as additional limitations. Their parent claims are not obvious as discussed above, in light of Cassidy in view of Ghaffar. Furthermore, Bazerman does not teach or suggest the features necessary to overcome the deficiencies of Cassidy and Ghaffar. Therefore, claims 7-8, 15-16, and 23-24 are not rendered obvious by Cassidy in view of Ghaffar and further in view of Bazerman. Thus, the rejection of claims 7-8, 15-16, and 23-24 under 35 U.S.C. § 103(a) has been overcome.

**VI. 35 U.S.C. § 103, Obviousness (Claims 26-30)**

The examiner has rejected claims 26-30 under 35 U.S.C. §103(a) as being unpatentable over Cassidy in view of Bazerman. This rejection is rendered moot in light of the cancellation of claims 26-30.

**VII. 35 U.S.C. § 103, Obviousness (Claims 31)**

The examiner has rejected claim 31 under 35 U.S.C. §103(a) as being unpatentable over Cassidy in view of Fu (U.S. Patent Publication No. US2005/0044502A1). This rejection is rendered moot in light of the cancellation of claim 31.

**VIII. CONCLUSION**

It is respectfully urged that the subject application is patentable over Cassidy et al., Ghaffar et al., Bazerman et al, and Fu and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Applicants hereby authorize the Commissioner to charge any additional fees or refunds that may be required by this paper to Electronic Data Systems Corporation Deposit Account No. 05-0765. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Electronic Data Systems Corporation Deposit Account No. 05-0765.

If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.




ATTY. DOCKET NO. 119166.1021 (LEDS.00116)  
CUSTOMER NO. 38851

AMENDMENT  
SERIAL NO. 10/715,013

Please direct all correspondence to the practitioner  
listed below at Customer No. 38851.

Respectfully submitted,



---

Stephen R. Loe  
Registration No. 43,757

Gardere Wynne Sewell LLP  
Thanksgiving Tower  
1601 Elm Street, Suite 3000  
Dallas, Texas 75201-4761  
Telephone: 214.999.4344  
Facsimile: 214.999.3344  
Email: sloe@gardere.com

ATTORNEY FOR APPLICANTS

December 6, 2006